

REMARKS

Despite the earlier indication that claims 1-9 were allowable, the present Office Action rejects claims 1-9. In view of the fact that previously presented claims 10, 11, and 21 were canceled in reliance on the statement that claim 1-9 were allowable, Applicants are now adding 22-24, which are simply previous claims 10, 11, and 21. This action is predicated on the Examiner's change in position.

Claims 1 and 4 were rejected as being anticipated by Bean. Claims 2 and 3 were rejected as being unpatentable over Bean in view of Svetlik or Bidanset. Applicants respectfully traverse.

Each of the rejections based on Bean is predicated on an analysis of the drawings of Bean where several measurements were made of the drawings of Bean and compared to alleged dimensions of an actual device. Such an analysis is improper and contrary to Federal Circuit precedent. Furthermore, the dimensions recited for the "real" saw are unsubstantiated.

As an initial matter, "it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Nystrom v. TREX Co.*, 76 USPQ2d 1481, 1491 (Fed. Cir. 2005) (citing *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000)). Here, the specification of Bean is completely silent with respect to the scale of its drawings. Therefore, the interpretation of Bean is erroneous and the rejection must be withdrawn.

Claims 1 and 4-9 were rejected as being unpatentable over Brunson in view of Bean and Pause. (For that matter, previously presented claims 10 and 11 were rejected as being unpatentable in view of Brunson and Pause).

The Action relies on Bean asserting that it “teaches a specific size of the palm pad as presented in paragraph 3” of the Office Action. As pointed out above, reliance on Bean in this manner is erroneous. Thus, any assertion that Bean discloses any particular dimension cannot stand and thus, the rejection must be withdrawn.

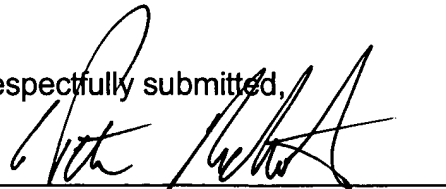
With respect to the combination of Brunson and Pause, the sole articulated motivation for combining Brunson and Pause is that to do so would “increase the adjustability of the handle in the Brunson’s saw”. (Office Action, p. 2, para. 4). There is, however, no identification provided as to where this motivation is derived.

As the Federal Circuit recently reiterated, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *In re Kahn*, 441 F.3d 977, 78 USPQ2d 1329, (Fed. Cir. 2006). Rather, the basis on which it is concluded that it would have been obvious to make the claimed invention must be articulated. In practice, this requires an explanation why one of ordinary skill in the art would have been motivated to select the references and to combine them. Without any explanation, there is an inference that the hindsight was used. Here, there is only the simple conclusion that modifying Brunson would increase the adjustability of the handle. While that may be true, it does not explain, as the Federal Circuit requires, why one skilled in the art would have been motivated to make such a modification.

There is nothing in Brunson that suggests that such a modification should have been made, would have been desirable, or would have solved any particular problem. Pause arrived at his invention in order to solve the problem when "an angular cut is to be made in a position that is not easily accessible ... the handle [can be moved] in the desired angular position". (lines 70-86). The problem facing Pause is not one that the user of the Brunson device would face. Thus, Pause does not provide any motivation to one of ordinary skill in the art to modify Brunson. Without any motivation, the proposed combination does not establish a *prima facie* case of obviousness and the rejection should be withdrawn.

Applicants believe that the claims are allowable, as previously indicated, and Applicants respectfully request that a Notice of Allowance be issued. If, for any reason, the Examiner feels that the above amendments and remarks do not put the claims in condition for allowance, the undersigned attorney can be reached at (312) 321-4276 to resolve any remaining issues.

Respectfully submitted,



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